



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/891,308	07/10/97	ONAGI	N 3577-180

LMC1/0801

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EXAMINER

CHU, K

ART UNIT	PAPER NUMBER
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2752

11

DATE MAILED: 08/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/891,308

Applicant(s)

ONAGI, NOBUAKI

Examiner

Kim-Kwok CHU

Art Unit

2752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Response to Argument

1. Applicant's arguments filed on May 9, 2000 have been fully considered but they are not persuasive.

Applicant states that the new claims 11-23 are to correct the error that was made by amendment to overcome the 35 USC 112 rejection. However, the Examiner considers that there is no error in Applicant's 08/126,515 amendment. In fact, said amendment is made to overcome the Examiner's 103 rejection. On the other hand, the 112 rejection is about not sufficient support of "super resolution reproduction" and indefinite on how to reproduce "address it".

(a) in claims 11, 14 and 20, the previous amended feature "magneto-optical disk" and "magnetization directions" are not included. These limitation is added to overcome the Examiner's 103 rejection. Therefore, new claims 11-23 without above said features are considered improper recapture of canceled claimed subject matter (an optical disk) surrendered in the application for the patent upon which the present reissue is based; and

(b) in claims 11, 14 and 20, the previous amended feature "high pit density" and "low pit density" are not included. These limitation is added to overcome the Examiner's 103 rejection and it is not an error.

Recapture Claims Rejection

2. Claims 11-23 are rejected under 35 U.S.C. 251 as being an improper recapture of canceled claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In application 08/126,515, Applicant filed amendment dated December 27, 1994 to overcome the Examiner's 103 rejection. Applicant/patentee adds the following new features to claim 1-8:

(a) "a plurality of information pits recorded on a plurality of recording tracks **as magnetization direction** at the recording surface in a magneto-optical recording operation";

(b) "the information pits are arranged with such **a high pit density as to be non-reproducible by a normal resolution reproducible by use of a light spot with a predetermined diameter but reproducible by a super resolution reproduction by use of a light spot the predetermined diameter**"; and

(c) "the address pit is **being arranged with such a low pit density as to be reproducible by a normal resolution**

reproduction by use of the light spot of the predetermined diameter" (emphasis added).

Applicant states that the above new features are not taught by the cited art. In response, the examiner allowed the '515 application with claims 1-10.

On the record, the newly submitted claims 11-23 without the aforementioned highlighted features.

In other words, the claims 11-23 are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Examiner's attention is directed to MPEP 1412.02 and 1412.03.

ALLOWANCE

3. Claims 1-10 are allowable over the prior art of record.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any response to this action should be mailed to:
Commissioner of Patents and Trademarks Washington, D.C.
20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-9731, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

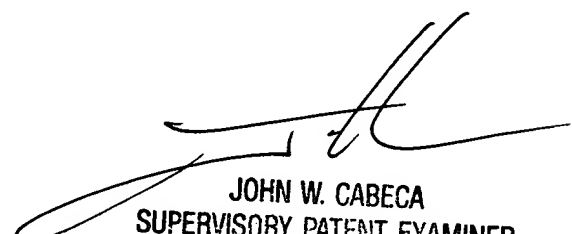
Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (703) 305-3032.

Kim-kwok CHU
Examiner AU2752
July 27, 2000

(703) 305-3032


JOHN W. CABECA
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